

Application No. 10/075,488
Amendment dated December 11, 2003
Reply to office action dated September 11, 2003

Remarks/Arguments

The preceding amendments and following remarks are submitted in response to the Official Action of the Examiner mailed September 11, 2003. Claims 1 and 3-27 remain pending. Reconsideration, examination and allowance of all pending claims are respectfully requested.

As a preliminary matter, Applicant submitted two supplemental IDSs on May 6, 2003, and another supplemental IDS on August 15, 2003. *Applicant respectfully requests that the Examiner consider these references, and provide initialed copies of the FORM-1449s filed therewith in due course.*

In paragraph 3 of the Office Action, the Examiner rejected claims 1, 3, 4, 7, 12-14, 18, 19, 23 and 27 under 35 U.S.C. § 102(b) as being anticipated by Brookman (U.S. Patent No. 5,337,225). The Examiner states, among other things, that Brookman suggest two legs that are adapted to secure the elongated member 82 to a support member (citing Figure 4, reference numbers 90 and 92).

First, Applicant would like to point out that the two legs 90 and 92 of Brookman are not adapted to secure the elongated member 82 to a substrate. Rather, the two legs 90 and 92 are adapted to secure the elongated member 82 to bracket member 98, which is not a substrate 88. It is the bracket member 98 that is secured to the substrate 88. Thus, Brookman do not suggest an “elongated member having one or more legs that are adapted to secure the elongated member to a substrate”, as recited in claim 1. Despite the foregoing, Applicant has amended claim 1 to recite:

1. (Currently Amended) A lighting apparatus for receiving an

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elongated light source, comprising:

an elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by a first material that is at least partially transparent and extends from the cavity to an outer surface of the elongated member and a second material that is substantially non-transparent, the elongated member having one or more legs that are adapted to extend at least partially into and secure the elongated member to a relatively planar substrate.

As can be seen, claim 1 now recites that the elongated member includes one or more legs that are adapted to extend at least partially into and secure the elongated member to a relatively planar substrate. Clearly, the legs 90 and 92 do not extend at least partially into and secure the elongated member to relatively planar substrate 88. For these reasons, as well as other reasons, claim 1 is believed to be clearly patentable over Brookman. For similar and other reasons, dependent claims 3-10 are also believed to be clearly patentable over Brookman.

Specifically with respect to claims 3 and 4, the Examiner states on page 3 of the Office Action that Brookman suggest that the first material and the second material are integrally formed (citing Figure 4, column 3, lines 61-63), and also that the first material and the second material are formed separately and secured together later (citing Figure 4). Column 3, lines 61-63 of Brookman state "...and a polymeric molding 82 having an opaque portion 84 and a transparent portion 86". This passage, however, cannot state that the opaque portion 84 is integrally formed, and is also separately formed and later secured together, as the Examiner suggests. These appear to be mutually exclusive conclusions.

Turning now to claim 12. Claim 12 has been amended to recite:

12. (Currently Amended) A lighting apparatus for receiving an

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elongated light source, comprising:

an elongated body having a ~~an upper~~ first surface and one or more other surfaces, the elongated body further having a cavity for receiving the elongated light source, wherein the cavity is at least partially defined by a material that is at least partially transparent which extends from the cavity to the ~~upper~~ first surface of the elongated ~~member~~ body and a second material that is substantially non-transparent; and

one or more legs that extend out from one or more of the other surfaces of the elongated body, the one or more legs including means to aid in securing the elongated body directly to a relatively planar substrate.

As noted above, the two legs 90 and 92 of Brookman are not adapted to secure the elongated member 82 to a relatively planar substrate. Rather, the two legs 90 and 92 appear to be adapted to secure the elongated member 82 to bracket member 98. It is the bracket member 98 that is secured to a relatively planar substrate. Thus, Brookman do not suggest “one or more legs including means to aid in securing the elongated body directly to a relatively planar substrate”, as recited in claim 12. In fact, it appears that Brookman would actually teach away from such a construction because Brookman suggest indirectly securing the elongated member 82 to the substrate through bracket member 98. For these reasons, as well as other reasons, claim 12 is believed to be clearly patentable over Brookman. For similar and other reasons, dependent claims 13-17 are also believed to be clearly patentable over Brookman.

Specifically with respect to claim 13, Applicant fails to see where Brookman shows or suggests one or more legs that extend out into the substrate to help secure the elongated member to the substrate, as recited in claim 13. As noted above, the legs 90 and 92 of Brookman engage the bracket member 98, and not the substrate 88. If the Examiner elects to maintain this

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rejection, Applicant respectfully requests that the Examiner specifically point out where in Brookman this is shown or suggested.

Turning now to claim 18. To provide further clarity, claim 18 has been amended to recite:

18. (Currently Amended) A lighting apparatus for a relatively planar substrate, comprising:

an elongated member adapted to be positioned in or adjacent to the substrate, the elongated member having a cavity for receiving the elongated light source, and one or more integrally formed legs that extend from the elongated member and are adapted to extend into the substrate to help secure the elongated member to the substrate.

As can be seen, claim 18 recites one or more integrally formed legs that extend from the elongated member and are adapted to extend into the substrate to help secure the elongated member to the substrate. Thus, for the same reasons given above with respect to claim 1 above, as well as other reasons, claim 18 is believed to be clearly patentable over Brookman. For similar and other reasons, dependent claims 19-22 are also believed to be clearly patentable over Brookman.

Turning now to claim 23. Claim 23 has been amended to recite:

23. (Currently Amended) A lighting apparatus for receiving an elongated light source, comprising:

an elongated ~~member~~ body having a cavity for receiving the elongated light source, the cavity being at least partially defined by a first material that is at least partially transparent and extends from the cavity to an outer surface of the elongated ~~member~~ body, the elongated ~~member~~ body further including a non-transparent material that extends between the cavity and an outer surface of the elongated ~~member~~ body; and
wherein the elongated body includes a removable portion that is adapted to

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be selectively removable from the remainder of the elongated body to provide access to the elongated light source.

As can be seen, claim 23 now recites an elongated body that includes a removable portion that is adapted to be selectively removable from the remainder of the elongated body to provide access to an elongated light source. Nothing in Brookman suggests an elongated body that includes a removable portion that is adapted to be selectively removable from the remainder of the elongated body to provide access to an elongated light source. In fact, according to the Examiner, opaque portion 86 of Brookman is integrally formed with the remainder of the elongated member 82, and therefore, it cannot be removed to provide access to the light source as recited in claim 23.

In addition, claim 23 recites an elongated light source. In contrast, Brookman suggest using point light sources such as LEDs or incandescent light sources (see, for example, Brookman, column 3, lines 34-36). Much of the structure of Brookman, including the oppositely charge wires (e.g. oppositely charged wires 50 of Figure 3) and the metallic strips (e.g. metallic strips 132 of Figure 11), are provided to accommodate the point light sources, each of which have lead wires that must be connected to a lower source. Therefore, it cannot readily be argued that it would have been obvious to replace the point light sources of Brookman with an elongated light source, as recited in claim 23. Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432 (see, MPEP §2143.01). In

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the present case, there is no suggestion or motivation whatsoever in Brookman to replace the point light sources of Brookman with an elongated light source, as recited in claim 23. For these and other reasons, claim 23 is believed to be clearly patentable over Brookman.

Turning not to claim 27. Claim 27 has been amended to recite:

27. (Currently Amended) A lighting apparatus for receiving an elongated light source, comprising:
an elongated body having ~~an upper~~ a first surface and one or more other surfaces, the elongated body further having a cavity for receiving the elongated light source, wherein the cavity is at least partially defined by a material that is at least partially transparent which extends from the cavity to the ~~upper~~ first surface of the elongated ~~member~~ body, the elongated body including a removable portion that includes the cavity, the removable portion being adapted to be selectively removable from the remainder of the elongated body to provide access to the elongated light source.

As can be seen, claim 27 recites an elongated body that includes a removable portion. Claim 27 also recites that the removable portion includes the cavity, and that the removable portion is adapted to be selectively removable from the remainder of the elongated body to provide access to the elongated light source. For similar reasons to those give above with respect to claim 23, as well as other reasons, claim 27 is believed to be clearly patentable over Brookman.

In paragraph 5 of the Office Action, the Examiner rejected claims 5, 6, 8, 11 and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Brookman. For the same reasons discussed above, dependent claims 5, 6, and 8 are also believed to be clearly patentable over Brookman. Specifically with respect to claim 6, however, the Examiner states that it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to use legs with the laterally extending teeth of Brookman's Figure 2, since the use of such structures are old and well known in the art as evidenced by Brookman. The Examiner also states that the bracket member could be fastened by any of the mechanical fasteners known in the art.

Applicant respectfully disagrees. Claim 6 recites:

6. (Previously Presented) A lighting apparatus according to claim 1 wherein the elongated member includes two or more legs each having a tooth that extends laterally away from the leg, each tooth being adapted to engage a back side of the substrate after the two or more legs are inserted through a hole in the substrate.

As can be seen, claim 6 recites that the elongated member includes two or more legs each having a tooth that extends laterally away from the leg, each tooth being adapted to engage a back side of the substrate after the two or more legs are inserted through a hole in the substrate. Nowhere do the teeth (shown in Figure 2 or any other Figure of Brookman) engage the back side of a substrate. In fact, the teeth in Figure 2 are actually part of the bracket member 42 (and not on the lighting strip section 22), and they extend away from the substrate 38. Applicant does not believe it can readily be argued that Brookman suggest providing an elongated member that includes a cavity for receiving an elongated light source, and further includes two or more legs each having a tooth that extends laterally away from the leg, wherein each tooth is adapted to engage a back side of the substrate after the two or more legs are inserted through a hole in the substrate. For these and other reasons, claim 6 is believed to be clearly patentable over

Brookman.

Turning now specifically to claim 8. Claim 8 recites:

8. (Original) A lighting apparatus according to claim 1 wherein the one or more legs are spaced along the length of the elongated member.

As can be seen, claim 8 recites that the one or more legs are spaced along the length of the elongated member. Claim 8 is supported at, for example, Figure 45 of the present specification.

Figure 45 is reproduced below for the convenience of the Examiner:

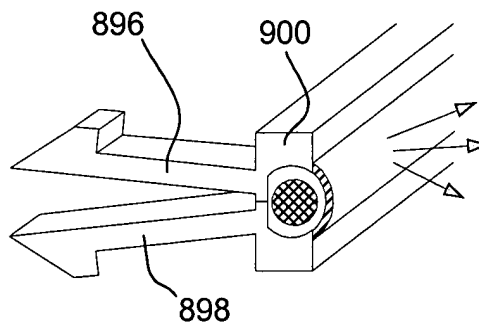


FIG. 45

The present specification states:

Figure 45 is a cross-sectional side view of another illustrative lighting apparatus with one or more legs for securing the lighting apparatus to a substrate. This illustrative embodiment is similar to the embodiment shown in Figure 44, except the first leg 896 and the second leg 898 do not extend continuously along the length of the main body portion 900. Rather, and in one embodiment, one or more first and second leg pairs 896, 898 are provided periodically along the length of the main body portion. Only one first and second leg pair is shown.

Brookman does not suggest in any way one or more legs that are spaced along the length of the

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elongated member, as recited in claim 8. As such, claim 8 is believed to be clearly patentable over Brookman.

Now turning to claim 11. Claim 11 recites:

11. (Original) A lighting apparatus for receiving an elongated light source, comprising:
an elongated member having a cavity for receiving the elongated light source, the elongated member having one or more legs each with one or more substrate engagers, wherein the one or more substrate engagers are adapted to engage a back side of the substrate after the one or more legs are inserted through a hole in the substrate.

As can be seen, claim 11 recites an elongated member having a cavity for receiving the elongated light source, wherein the elongated member has one or more legs each with one or more substrate engagers, and the one or more substrate engagers are adapted to engage a back side of the substrate after the one or more legs are inserted through a hole in the substrate. For the same reasons given above with respect to claim 6, as well as other reasons, claim 11 is believed to be clearly patentable over Brookman. For similar and other reasons, claims 24-25 are also believed to be clearly patentable over Brookman.

Now turning to claim 26, which recites:

26. (Previously Presented) A lighting apparatus for receiving an elongated light source, comprising:
an elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by a first material that is at least partially transparent and extends from the cavity to an outer surface of the elongated member, the elongated member having one or more integral legs that are adapted to secure the elongated member to a substrate, wherein the one or more integral legs are spaced at intervals along the length of the elongated

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member.

As can be seen, claim 26 recites that the one or more integral legs are spaced at intervals along the length of the elongated member. Thus, for the same reasons given above with respect to claim 8, as well as other reasons, claim 26 is believed to be clearly patentable over Brookman.

In paragraph 6 of the Office Action, the Examiner rejected claims 9, 10, 21 and 22 under 35 U.S.C. 103(a) as being unpatentable over Brookman. As noted above, Brookman clearly suggest using point light sources such as LEDs or incandescent light sources (see, for example, Brookman, column 3, lines 34-36). In addition, much of the structure of Brookman, including the oppositely charge wires (e.g. oppositely charged wires 50 of Figure 3) and the metallic strips (e.g. metallic strips 132 of Figure 11), are provided to accommodate the point light sources, each of which has lead wires that must be electrically connected to a power source. Therefore, it cannot readily be argued that it would have been obvious to replace the point light sources of Brookman with an elongated light source such as an electro-luminescent wire or a linear emitting fiber. As noted above, there is simply no motivation whatsoever in Brookman to do so. For these and other reasons, claims 9, 10, 21 and 22 are believed to be clearly patentable over Brookman.

Finally, in paragraph 7 of the Office Action, the Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Brookman. The Examiner states that Brookman does not disclose a substrate that includes a material that can be initially provided in a liquid or semi-

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liquid state, and then cured or hardened to a more solid state around the legs. However, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the material used by Brookman (polymeric materials and that of the surface to which the structure is mounted) can be initially provided in a liquid or semi-liquid state, and then cured or hardened to a more solid state around the legs.

Applicant respectfully disagrees. Applicant would again like to point out that although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432 (see, MPEP §2143.01). In the present case, there is no suggestion or motivation whatsoever in Brookman to provide a substrate that includes a material that can be initially provided in a liquid or semi-liquid state, and then cured or hardened to a more solid state around the one or more legs of the elongated member. In view thereof, claim 20 is believed to be clearly patentable over Brookman.

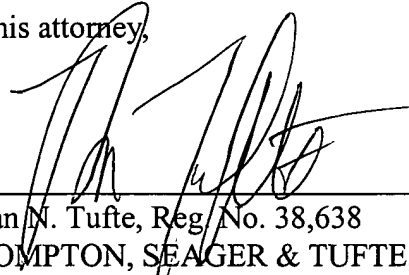
In view of the foregoing, Applicant believes that all pending claims 1 and 3-27 are now in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the undersigned attorney at (612) 573-2002.

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Respectfully submitted,

Brian N. Tufte

By his attorney,

A handwritten signature in black ink, appearing to be 'BT', is written over a horizontal line.

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